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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,588	08/17/2001	James T. Pantaja	018167-003800US	5221
6449	7590	01/11/2005	EXAMINER	
ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005			LASTRA, DANIEL	
		ART UNIT	PAPER NUMBER	
		3622		

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/932,588	PANTTAJA ET AL.	
	<b>Examiner</b> DANIEL LASTRA	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 27 October 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-21 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

1. Claims 1-21 have been examined. Application 09/932,588 (Redemption System for Award Redemption) has a filing date 08/17/2001.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7-13 and 15-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Eggleston (U.S. 6,061,660).

As per claim 1, Eggleston teaches:

A method in a redemption system for determining which awards to redeem, the method comprising:

maintaining an award history database that includes award transaction information that describes awards earned by a consumer and, for each earned award, the type of award (see column 12, line 58 – column 13, line 27; column 16, lines 47-67);

maintaining an encumbrance database that describes types of awards that cannot be redeemed at one or more suppliers (see column 20, lines 9-16; column 35, line 50 – column 36, line 20; column 41, lines 5-10; column 43, lines 22-40);

receiving a request to redeem an amount of the earned awards at a chosen supplier (see column 43, lines 23-40);

determining allowed awards that can be redeemed with the chosen supplier (see column 43, lines 22-40; column 44, lines 1-40);

determining encumbrance levels of the allowed awards based on the types of allowed awards and the data in the encumbrance database (see column 20, lines 9-16; column 21, lines 45-55; column 35, line 49 – column 36, line 20; column 43, lines 22-40); and

determining which of the allowed awards to redeem based on the encumbrance levels (see column 35, line 3 – column 36, line 20).

As per claim 2, Eggleston teaches:

The method of claim 1 wherein determining which of the allowed awards to redeem is further based on expiration dates of the allowed awards (see column 19, lines 10-15; column 29, lines 60-65; column 33, lines 40-45; column 35, lines 3-20).

As per claim 3, Eggleston teaches:

The method of claim 1 wherein determining which of the allowed awards to redeem is further based on dates on which the allowed awards were earned (see column 27, lines 20-25).

As per claim 4, Eggleston teaches:

The method of claim 1 wherein the type of award includes according to which promotion the award was earned (see column 42, lines 32-67).

As per claim 5, Eggleston teaches:

The method of claim 1 wherein the type of award includes from which business the award was earned (see column 41, lines 5-8; column 43, lines 23-40).

As per claim 7, Eggleston teaches:

The method of claim 1 wherein the type of award indicates a classification of the award (see column 13, lines 55-60).

Claim 8 contains the same limitations as claims 2 and 3 therefore the same rejection is applied.

Claim 9 contains the same limitations as claim 1 therefore the same rejection is applied.

Claim 10 contains the same limitations as claim 1 therefore the same rejection is applied.

Claim 11 contains the same limitations as claim 1 therefore the same rejection is applied.

Claim 12 contains the same limitations as claim 4 therefore the same rejection is applied.

Claim 13 contains the same limitations as claim 5 therefore the same rejection is applied.

Claim 15 contains the same limitations as claim 7 therefore the same rejection is applied.

Claim 16 contains the same limitations as claim 1 therefore the same rejection is applied.

Claim 17 contains the same limitations as claims 2 and 3 therefore the same rejection is applied.

Claim 18 contains the same limitations as claim 1 therefore the same rejection is applied.

Claim 19 contains the same limitations as claims 2 and 3 therefore the same rejection is applied.

Claim 20 contains the same limitations as claim 1 therefore the same rejection is applied.

Claim 21 contains the same limitations as claim 1 therefore the same rejection is applied.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston (U.S. 6,061,660).

As per claim 6, Eggleston does not expressly teach:

The method of claim 1 wherein the type of award indicates black-out dates on which the award cannot be redeemed. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that if the Eggleston's award system indicates expiration dates after which the prize would not

be redeemed, the Eggleston's award system would also indicate black-out dates where prizes would also not be redeemed. This feature would be a business decision that would not patentably distinguish the claimed invention from the prior art.

Claim 14 contains the same limitations as claim 6 therefore the same rejection is applied.

***Response to Arguments***

4. Applicant's arguments filed 10/27/04, with respect to the rejection(s) of claim(s) 1-21 under Kelly have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Eggleston.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra  
January 3, 2005

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Primary Examiner  
AU 3622